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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,242	09/17/2003	Eric Mark Chelgren		3745

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11/22/2004

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EXAMINER

LUBY, MATTHEW D

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,242

Applicant(s)

CHELGREN, ERIC MARK *S*

Examiner

Matt Luby

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-8 is/are rejected.
- 7) ☒ Claim(s) 4 and 9-11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, drawn to a wheelchair rear wheel suspension apparatus, classified in class 280, subclass 250.1.
 - II. Claim 12, drawn to a wheelchair rear wheel suspension apparatus, classified in class 280, subclass 304.1.
 - III. Claims 13-20, drawn to a wheelchair, classified in class 280, subclass 283.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require that abutment of the first surface of the fork member on the first surface of the mounting member limits movement of the free end of the fork member away from the mounting member. The subcombination has separate utility such as in a suspension apparatus that does not have a shock absorber damping vertical movement of the fork.

Inventions III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require a shock absorber damping vertical movement of the fork. The subcombination has separate utility such as in a wheelchair that dampens vertical movement of the fork.

Inventions III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require that abutment of the first surface of the fork member on the first surface of the mounting member limits movement of the free end of the fork member away from the mounting member. The subcombination has separate utility such as in a wheelchair wherein abutment of the first surface of the fork member on the first surface of the mounting member limits movement of the free end of the fork member away from the mounting member.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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3. During a telephone conversation with Alan Harms on 11/10/04 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "the base member" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Pulver et al. (U.S. Patent No. 6,131,679).

Pulver et al. disclose a suspension apparatus for a rear wheel (72) of a wheelchair (bottom half shown in Figure 2; prior art top half shown in Figure 1) comprising: a mounting member (the integral member including sub-members 40 and 44) mounted to a frame member (10; member 40 + 44 is mounted to 10 at 42 as shown in Figure 2) of the wheelchair; an elongate fork (52) hingedly mounted to the mounting member (at 56 by 66); the fork member including a hinge end (towards 66 as seen in Figure 3) and a free end (towards 74 as seen in Figure 3); a rear wheel axle receiving opening (which 74 goes through - as seen in Figures 3 and 4) at the free end of the fork member; a shock absorber (68) disposed between the for (52) and the mounting member (40 + 44 - shown in Figures 2-4); the shock absorber damping vertical movement of the fork (since it is clear from Figure 2 that the fork, 52, is moved through and angle - it has at least a vertical component of movement which is therefore damped by the shock absorber, 68); wherein the mounting member is detachably mounted to the frame member of the wheelchair (at 42 as shown in Figure 2 and detached as shown in Figure 4); wherein pivot limiting means is provided for restricting the free end of the fork member (the tension of the spring, 68, as well as the shape of the top of members 52 and 44, aid in preventing unlimited movement of the fork member free end) and wherein a first surface of the fork member (52) abuts a first surface on the mounting member (40 + 44) when the shock absorber is fully decompressed (as shown in Figure 2, a rightward most surface of fork member, 52, is positioned progressively closer to the rear surface

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of the mounting member, 40 + 44, as shock absorber, 68, is decompressed - the Examiner is interpreting the word abut to mean "to touch; to lie adjacent", in particular "to lie adjacent" as defined in the Microsoft Bookshelf Basics dictionary.)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pulver et al. in view of Peterson (U.S. Patent No. 6,161,856).

Pulver et al. disclose all of Applicant's claimed invention except that the shock absorber is entirely polymeric/comprises an elongate cylinder of solid polymeric material. Peterson disclose a shock absorber (19) for the rear wheels of a wheelchair (shown in the Figures) that is entirely polymeric/comprises an elongate cylinder of solid polymeric material (col. 4, lines 46-38 state that the shock absorber is made of an elastomer - which is within the family of polymers) in order to provide an economical, light-weight shock absorption system for a wheelchair (since col. 5, lines 33-40 state that this is what is provided by the wheelchair of Peterson and since the shock absorber is part of Peterson's invention, this is naturally one of the benefits that the shock absorber helps to provide.) It would have been obvious to one of ordinary skill in the art at the time of the invention to provide that the shock absorber of Pulver et al. is entirely

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polymeric/comprises an elongate cylinder of solid polymeric material, as taught by Peterson, in order to provide an economical, light-weight shock absorption system for a wheelchair.

Allowable Subject Matter

10. Claim 6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. Claims 4 and 9-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matt Luby whose telephone number is (703) 305-0441. The examiner can normally be reached on Monday-Friday, 9:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matt Luby
Examiner
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A handwritten signature in black ink, appearing to read "Matt Luby", written in a cursive style.

M.I.
November 17, 2004